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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/080,458      | 02/22/2002  | Stanley Pohl         | CP-1235             | 8402             |

27752 7590 09/21/2004

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[REDACTED] EXAMINER

MARKOFF, ALEXANDER

[REDACTED] ART UNIT [REDACTED] PAPER NUMBER

1746

DATE MAILED: 09/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |
|------------------------------|------------------------|---------------------|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |
|                              | 10/080,458             | POHL, STANLEY       |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |
|                              | Alexander Markoff      | 1746                |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 18 August 2004.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-24 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/18/04 has been entered.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 17-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The applicants amended claim 17 to recite the range for "hydrogen peroxide oxidizing agent" to be from about 6%. This is not supported by the original disclosure. The only place in the original disclosure wherein 6% are mentioned is page 10, line 20-24. However, at that place, the specification states that 6% solution is a preferred form in which the oxidizing agent is presented in the composition. This is not a recitation of the ranges of concentration of hydrogen

peroxide in the composition. The ranges of the concentrations are disclosed at page 9, lines 25-30.

### ***Election/Restrictions***

4. It is noted that the instant claims are directed to distinct inventions, which can properly restricted. No restriction requirement is made this time because the same prior art is applied to claims directed to these distinct inventions. However, the applicants are advised, that if the claims would be amended to put a serious burden on the examiner in further examination, such requirement can be issued.

### ***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-7, 9, 15-17 and 23-24 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of copending Application No. 10/080,459. Although the conflicting claims

are not identical, they are not patentably distinct from each other because of the following:

The difference between the instant claims and the claims of the copending application is that the claims of the instant application recite an anionic amphiphilic polymer, while the claims of the copending application recite an acrylate copolymer.

Thus the scope of the claims of copending application is inside of the scope of the claims of the instant application.

7. Claims 8, 10-14, 18-22 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of copending Application No. 10/080,459 in view of the state of the prior art admitted by the applicants in the specification (pages 1-3 and 7) and Dias et al (US Patent No 6,432,147, WO 98/27945).

The difference between the claims of the instant application and the claims of the copending application is that the claims of the instant application recite the specific acrylate copolymers, when the claims of the copending application recite a genus of acrylate copolymers.

On the other hand, the applicants admitted in the specification that all the specifically claimed copolymers are commercially available. Moreover, the admitted prior art and Dias et al teach that at least some of the claimed copolymers were conventional parts of the hair coloring compositions comprising the same ingredients as recited by the claims.

It would have been obvious to an ordinary artisan to use commercially available species of the disclosed genus in the method and the composition of the copending application with a reasonable expectation of adequate results in order to have a reliable source of the chemicals because these species were conventionally used in the similar compositions.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 17-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dias et al (US Patent No 6,432,147, WO 98/27945).

The relevant parts are cited using the US Patent.

Dias et al teach a hair coloring composition comprising the claimed ingredients: hydrogen peroxide; claimed polymer in the claimed range (see at least column 25, lines 50-67); claimed phosphate ester surfactant (see at least column 27, lines 41-53); claimed co-solvents (see at least column 26, lines 1-24); and water (see at least column 26, lines 1-5).

Dias et al teach the claimed pH. See at least Abstract, columns 5 and 10, claims 1-2.

Dias et al does not specifically teach a range for the concentration of the claimed surfactant. However, in all the examples surfactants are presented in the range 1.5-1.7%. This concentration is in the claimed range.

It would have been obvious to an ordinary artisan at the time the invention was made to provide any of the disclosed surfactants in this range with reasonable expectation of adequate results because this range is recommended by the reference.

Dias et al does not specifically teach the concentration of hydrogen peroxide in the claimed range. They recommend lower concentrations because of the concerns of the effect of the high concentrations on human hair. Dias et al however, teach that conventional compositions of the prior art have much higher concentrations of hydrogen peroxide. It would have been obvious to an ordinary artisan at the time the invention was made to find an optimum concentration of the active ingredient by routine experimentation and increase the concentration of the hydrogen peroxide in the

composition of Dias et al up to the conventional ranges for applications wherein the composition is to be applied to “non-living hair” in order to obtain faster application times when the irritation of skin and damage of the “living” hairs is not a concern.

It is noted that the concentrations of hydrogen peroxide, which are specifically recited by Dias et al are inside of the preferred range disclosed by the instant specification, accordingly no unexpected results are provided by the newly claimed range.

11. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over the state of the prior art admitted by the applicants in the specification (pages 1-3) in view of Dias et al (US Patent No 6,432,147, WO 98/27945).

The applicants admitted in the specification that thickened hair dye compositions comprising acrylate copolymers leave a polymeric film on the stainless steel equipment.

The applicants also admitted that this film is conventionally removed by a hot alkaline solution.

Dias et al teaches a hair coloring composition, which is thickened by acrylate copolymers.

It would have been obvious to an ordinary artisan at the time the invention was made that such composition would leave the polymer film disclosed by the admitted prior art.

It would have been obvious to an ordinary artisan at the time the invention was made to remove this film by a conventional prior art method, i.e. by cleaning with an alkaline solution with reasonable expectation of adequate results.

The composition of Dias et al comprises the claimed ingredients and has the claimed pH.

Thus the prior art cleaning method applied to the equipment used with the composition of Dias et al would meet the claimed limitations.

As to claims 15 and 16:

The admitted prior art does not disclose the pH of the used alkaline solution and fails to disclose a cleaning pressure.

However, the pH (concentration) of the cleaning solution and the pressure of the applied cleaning solution are result effective variables.

It would have been obvious to an ordinary artisan at the time the invention was made to find an optimum pH and an optimum application pressure by routine experimentation.

### ***Response to Arguments***

12. Applicant's arguments filed 8/18/04 have been fully considered but they are not persuasive.

The applicants have amended the claims and argue that Dias does not disclose the claimed concentration of hydrogen peroxide. This limitation has been addressed above in the instant Office action.

The applicants again argue that the concentration range for the surfactant in Dias is not exemplified for the specifically claimed surfactant. This is not persuasive because the teaching of the reference is not limited to the examples.

The applicants again argue that incorporating the specific surfactant provides unexpected results.

This is not persuasive. The examiner, without making a conclusion regarding whether or not the improvement is unexpected, would like to note that the presented in the specification data does not support improvements of the results for the entire claimed range for the surfactant.

The applicants presented no additional evidence that the entire claimed range would provide unexpected results.

The fact that improvement is obtained at 5% of ester surfactant is not sufficient to show unexpected results for the range from 0.5% to 5%.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Markoff whose telephone number is 571-272-1304. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Barr can be reached on 571-272-1414. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Alexander Markoff  
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Art Unit 1746

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